

REMARKS

In an Official Action dated February 21, 2006, the Examiner has indicated that restriction to one of the following inventions is required under 35 U.S.C. § 121:

- Group I Claims 1-28 and 31-35 (drawn to a pressable dental ceramic);
- Group II Claims 29-30 and 36-37 (drawn to a press to metal dental restoration; and
- Group III Claims 38-48 (drawn to a method of making a dental restoration).

Accordingly, Applicant provisionally elects Group I, the subject matter of claims 1-28 and 31-35, with traverse. Applicant submits that the restriction requirement is in error.

It is alleged in paragraph 2 of the official action that the inventions of Group I (claims 1-28 and 31-35) and II (claims 29-30 and 36-37) are "mutually exclusive species in an intermediate-final product relationship." It is further asserted that distinctness between Groups I and II if "the intermediate product is useful to make other than the final product, and the species are patently distinct (MPEP § 806.05(f))." It is respectfully submitted that the above-quoted assertions fail to set forth the appropriate standard upon which a restriction requirement can be based.

The above quoted portion of the MPEP, which is evidently relied upon as supporting the restriction requirement reads, in part:

To support a requirement for restriction between two or more related product inventions, or between two or more related process inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status in the art, or field of search. See MPEP § 808.02. See MPEP § 806.05(c) for an explanation of the requirements to establish two-way distinctness as it applies to inventions in a

combination/subcombination relationship. For other related product inventions, or related process inventions, the inventions are distinct if

(A) the inventions **as claimed** do not overlap in scope, i.e., are mutually exclusive;

(B) the inventions **as claimed** are not obvious variants; and

(C) the inventions **as claimed** are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

The burden is on the examiner to provide an example to support the determination that the inventions are distinct, but the example need not be documented. If applicant either proves or provides convincing evidence that the example suggested by the examiner is not workable, the burden is on the examiner to suggest another viable example or withdraw the restriction requirement.

As an example, an intermediate product and a final product can be shown to be distinct inventions if the intermediate and final products are mutually exclusive inventions (not overlapping in scope) that are not obvious variants, and the intermediate product as claimed is useful to make other than the final product as claimed. Typically, the intermediate loses its identity in the final product. (emphasis original)

When considered under the framework of the above-stated criteria, at least Groups I and II are not distinct and should be examined together in a single application.

With regard to criteria (A), there is very clear overlap between the subject matter recited in claims 1 and 19 of Group I, and claims 29 and 30 of Group II, as evident from the following table, wherein those portions of claims 1 and 19 which overlap with claims 29 and 30 appear in boldface type.

<u>Group I</u>	<u>Group II</u>
<p>1. A pressable dental ceramic comprising: a glass frit; a glass-ceramic frit comprising leucite; and a refractory filler having a thermal expansion lower than the thermal expansion of the frits and a refractive index within ± 0.2 of the refractive index of the frits; wherein leucite is present in the dental ceramic in an amount less than about 35% by weight; wherein the thermal expansion of the dental ceramic is in the range of about $12.5 \times 10^{-6}/^{\circ}\text{C}$ to about $14.5 \times 10^{-6}/^{\circ}\text{C}$ measured from room temperature to 500°C.; wherein the dental ceramic is pressable from about 980 to about 1030°C; and wherein the dental ceramic can withstand firing of a porcelain onto the dental ceramic without distortion of the dental ceramic at a range from about 830°C to about 900°C.</p>	<p>29. (As Amended) A press-to-metal dental restoration comprising: a metal framework; a pressed ceramic overlay, wherein the ceramic overlay comprises a glass frit, a glass-ceramic frit comprising leucite, and a refractory filler having a thermal expansion lower than the thermal expansion of the frits and a refractive index within ± 0.2 of the refractive index of the frits, wherein leucite is present in the dental ceramic in an amount less than about 35% by weight, and wherein the thermal expansion of the dental ceramic is in the range of about $12.5 \times 10^{-6}/^{\circ}\text{C}$ to about $14.5 \times 10^{-6}/^{\circ}\text{C}$ measured from room temperature to 500°C, wherein the dental ceramic is pressable from about 980 to about 1030°C, and wherein the dental ceramic can withstand firing of a porcelain onto the dental ceramic without distortion of the dental ceramic at a range from about 830 to about 900°C; and a porcelain overlay on the pressed ceramic having a maturing temperature higher than about 830°C.</p>
<p>19. A pressable dental ceramic comprising a: a glass frit; a glass-ceramic frit comprising leucite; and a refractory filler; wherein the glass frit has an average particle size equal to or greater than about six times the average particle size of the glass-ceramic frit.</p>	<p>30. A press-to-metal dental restoration comprising: a metal framework; a pressed ceramic overlay, wherein the ceramic overlay comprises a glass frit, a glass-ceramic frit comprising leucite, and a refractory filler, wherein the glass frit has an average particle size equal to or greater than about six times the average particle size of the glass-ceramic frit; and a porcelain overlay on the pressed ceramic having a maturing temperature higher than about 830°C.</p>

Thus, in light of the above, Groups I and II are not "mutually exclusive species," and criteria (A) cannot be satisfied.

In addition, as set forth in M.P.E.P. § 803, there are two criteria for a proper restriction requirement: (1) the inventions must be independent or distinct as claimed; and (2) there must be a **serious burden** on the Examiner if restriction is not required. This portion of the M.P.E.P. requires that if the search and examination of an entire application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions. In light of the significant overlap between the subject matter recited in the claims designated as corresponding to the different groupings, examination of all the claims together in a single application would not pose a "serious burden" to the Patent Office.

Accordingly, reconsideration and withdrawal of the aforementioned restriction requirement is respectfully requested. The provisional election is hereby made without prejudice to applicant's right to file a divisional application or applications should the restriction requirement become final.

Respectfully submitted,

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